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09/980,880	09/03/2002	Yoshio Goda	MAT-8189US	1394
53473	7590	08/19/2008		
RATNERPRESTIA			EXAMINER	
P.O. BOX 980			HODGE, ROBERT W	
VALLEY FORGE, PA 19482				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIO GODA, NORIO SUZUKI, and
KIYOSHI YAMASHITA

Appeal 2008-3281
Application 09/980,880
Technology Center 1700

Decided: August 19, 2008

Before CHUNG K. PAK, JEFFREY T. SMITH, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This case is not ripe for review and is, therefore, remanded to the Examiner for appropriate action. 37 C.F.R. § 41.50(a)(1); *see also Manual of Patent Examining Procedure* (MPEP) § 1208 (Eighth ed., Rev. 5, August 2006). Specifically, this case is remanded to the Examiner to comply with 37 C.F.R. §41.41(a)(2)-(b) regarding the Reply Brief and 37 C.F.R. §

41.37(c)(1) and (c)(1)(viii) regarding the Appeal Brief, and to clarify the status of the amendment filed with the Reply Brief as instructed below.

I. Reply Brief and Amendment

37 C.F.R. §41.41(a)(2)-(b) states:

- (2) A reply brief **shall not include** any **new or non-admitted amendment**, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.
- (b) A reply brief that is not in compliance with paragraph (a) of this section **will not be considered**. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(emphasis added).

On 17 May 2007, the Office received a Reply Brief accompanied by an amendment cancelling claims 3 and 4 made after the final rejection. of record. According to the *Manual of Patent Examining Procedure* (MPEP) § 1208, "[i]f a [R]epley [B]rief is not in compliance with 37 CFR [§] 41.41, the examiner must notify [A]ppellant[s] that the [R]epley [B]rief has not been considered and the reason for non-compliance." Rather than notifying Appellants of this non-compliance, the Examiner mailed an Office Action on 6 August 2007, acknowledging that the "[R]epley [Br]ief filed 5/17/07 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal." This Office Action did not indicate the status of the amendment filed with the Reply Brief.

II. The "Appendix of Claims" section of the Appeal Brief

37 C.F.R. § 41.37(c)(1) and (c)(1)(viii) in relevant part states "[t]he Brief shall contain. . . An appendix containing a copy of the claims involved in the appeal."

On 24 November 2006, the Office received an Appeal Brief filed by Appellants. On page 2 of the Appeal Brief under the heading "STATUS OF AMENDMENTS", Appellants stated, "the pending claims are in the form submitted by Appellants in the response of June 20, 2005." However, the claims included in the Appeal Brief do not correspond to the actual pending claims. Instead, they appear to reflect the claims in one of the after final amendments received by the Office on December 5, 2005, which was refused entry by the Examiner on December 14, 2005. Consequently, the Appeal Brief is not in compliance with the requirements of 37 C.F.R. § 41.37(c)(1) and (c)(1)(viii).

ORDER

For the foregoing reasons, we remand this application to the jurisdiction of the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) to:

(1) Send a notice of non-compliant Appeal Brief and Reply Brief for failure to comply with 37 C.F.R. §41.41(a)(2)-(b) and 37 C.F.R. § 41.37(c)(1) and (c)(1)(viii), respectively to provide Appellants an opportunity to correct the above-identified deficiencies in the Appeal and Reply Briefs; and

(2) Clarify the status of the after final amendment accompanying the Reply Brief in this record (notify Appellants of the status of this amendment).

Because this application is being remanded for further action, the application is a "special" application.” MPEP § 708.01(D). The Board should be informed of any action affecting the status of the appeal (e.g., abandonment, issue, reopening prosecution).

This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a Supplemental Examiner’s Answer is written in response to this remand by the Board after receiving the Appeal Brief and Reply Brief which comply with the above-identified Rules.

REMANDED

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